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Filed : April 14, 2000

REMARKS

After entry of the foregoing amendment, claims 1-3, 5-19, 21-33 and 35-55 are pending in the application and are presented for reconsideration and further examination in view of the foregoing amendments and the following remarks. By the foregoing amendments, claims 1, 11, 22, 27, 33, 37 and 46 have been amended and claims 10 and 21 have been cancelled without prejudice or disclaimer.

Rejections Under 35 U.S.C. § 112, first and second paragraphs

In the Office Action, claims 1-9 were rejected under 35 U.S.C. § 112, ¶ 1, as failing to comply with the written description requirement in that they contain “subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time of the application was filed, had possession of the claimed invention. Specifically, the Office Action states “claim 1 contains newly added subject matter ‘with different manufacturing capabilities associated with each product...’ which implies the selected product themselves have the capabilities to be manufactured differently and the examiner could not find support for this limitation in the specification.” Claims 2-9 were rejected because they are dependencies of claim 1. The Office Action also rejected claims 1-9 under 35 U.S.C. § 112, ¶ 2, as being indefinite because amended claim 1 failed to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office Action asserted amended claim 1 contains newly added subject matter “with different manufacturing capabilities associated with each product...” Presumably, claims 2-9 were rejected as for their dependencies on claim 1. Applicant respectfully traverses these rejections.

“Manufacturing capabilities” is disclosed in the specification on at least page 37, lines 26-29 to refer to, e.g., “parameter values, formats, condition, etc. associated with manufacturing, customizing, production, pre-production, post-production, finishing, incorporating files, images, text, audio, video, and the like, that are within the capabilities of a vendor.” The foregoing amendments amend the preamble of Claim 1 clarifying that the “manufacturing capabilities” are of “a plurality of vendors capable of producing the products available for personalization”. The foregoing amendments also amend the first element of claim 1 as shown below:

“providing to the user via said communication network at least one web page providing an assortment of product selections for products in the products database, each

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product available in the products database being associated with manufacturing capabilities of one or more vendors capable of producing the product;”

See, e.g., amended Claim 1. Applicants respectfully submit amended claim 1 does not contain new matter, that it is described in the specification to reasonably convey that the inventor(s) had possession on the claimed invention at the time the application was filed, and that amended claim 1 is clear and unambiguous. *See, e.g.*, Application page 45, lines 11-14; line 27 – page 46, line 3. Accordingly, Applicants request the withdrawal of the rejections of claim 1-10 under 35 U.S.C. § 112, first and second paragraphs.

Rejections Under § 103

In the Office Action, claims 1-3, 5-6, 9, 11-13, 15-17, 22-24, 26-30, 32, 35-41, 45-51 and 54-55 were all rejected under 35 U.S.C. § 103 as being unpatentable over von Rosen et al. (U.S. Patent No. 6,493,677) (“Rosen”) and further in view of Lahey (U.S. Patent No. 6,384,923) (“Lahey”). Applicant respectfully traverses this ground of rejection.

Generally, Rosen discloses customization of merchandise by adding, for example, a graphic image with certain size requirements or user specified text of a certain length, and Lahey discloses a user customizable search dialog box. *See, e.g.*, Rosen Figure 8A; col. 2, 23-39; col. 9, 58-60. *See, e.g.*, Lahey, Abstract. However, Rosen and Lahey references fail to disclose, for example, a method or system for facilitating the creation of personalized products where a *plurality of vendors, each having their own manufacturing capabilities, can make the same product*. For example, Rosen and Lahey do not disclose

“retrieving a set of manufacturing capabilities for the selected product from the [a]* products database, the set of manufacturing capabilities including the manufacturing capabilities of one or more vendors from the [a]* plurality of vendors that are capable of producing the selected product;” (*See*, claims 1 and 11) * (*See*, claim 27)

“retrieving a set of manufacturing capabilities for the product selected for personalization, the set of manufacturing capabilities including the manufacturing capabilities of one or more vendors from a plurality of vendors that are capable of producing the selected product;” (*See*, claim 22)

or

“a products database ..., said products database comprising information on an assortment of products available for personalization, and further comprising, for each product of the assortment of products, manufacturing capabilities of one or more vendors from a plurality of vendors that are capable of creating the product;” (*See*, claim 37 and 46)

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Also, Rosen and Lahey fail to disclose, in general, that a user can create a personalized product with a specialized design tool that only allows the creation of a personalized product which satisfy the manufacturing capabilities of at least one vendor of the vendors that are capable of producing the desired personalized product. Specifically Rosen and Lahey do not disclose

“...design tool is conformed to only allow configuration options and enhancements which satisfy the manufacturing capabilities of at least one vendor from the plurality of vendors capable of producing the selected product, and wherein said design interface presents to the user a default set of product configuration options and a default set of enhancements;” (See, claim 1)

“...design tool is adapted so that the user may only select configuration options and create enhancements which comply with said manufacturing capabilities of one or more vendors of the plurality of vendors capable of producing the selected product,” (See, claim 11)

“...design interface is adapted so that the user may only create design components which comply with said set of manufacturing capabilities of at least one vendor of the vendors capable of producing the selected product,” (See, claim 22)

“...design tool is conformed to only allow configuration options and enhancements which satisfy said manufacturing capabilities associated with one or more vendors from the plurality of vendors capable of producing the products and to initially present a set of default design components associated with said selected product,” (See, claim 33)

“...set of design tools is adaptable to only accept product configuration selections and individualized enhancements which comply with a set of manufacturing capabilities of one or more vendors capable of creating the selected product,” (See, claim 37)

or

“...said second module comprising at least one design tool that allows the user to select product configuration options and create individualized enhancements, wherein said design tool is adaptable to only accept product configuration selections and individualized enhancements which comply with a set of manufacturing capabilities associated with one or more vendors from the plurality of vendors capable of creating the selected product,” (See, claim 46)

Additionally, because Rosen and Lahey fail to disclose a system or method for facilitating the creation of personalized products by one vendor from a plurality of vendors capable of producing the product, they also do not disclose

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“selecting a vendor from the plurality of vendors, the selected vendor being capable of producing the selected product personalized with the set of design configuration selections and the set of individualized enhancements;

converting the set of design configuration selections and the set of individualized enhancements for said selected product into a file having a format compatible with the needs of the selected vendor; and

communicating the file to the selected vendor.” (See, amended claims 1, 22, 33)

or

“converting the set of product configuration options and set of individualized enhancements into a file having a format compatible with the needs of a first vendor capable of producing the selected product; and

communicating the file to the first vendor.” (See, amended claim 11)

The foregoing amendments to independent claims 1, 11, 22, 27, 33, 37, and 46 clarify aspects of the claims and incorporate limitations which are not disclosed, taught or suggested in Rosen or Lahey. For at least the reasons discussed above, Applicant respectfully submits that each of the pending independent claims and the claims which depend therefrom are in condition for allowance. If the Examiner has any further questions regarding the foregoing, he is invited to contact the undersigned by telephone.

CONCLUSION

The applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims for patentability purposes pursuant to statutory sections 103 and/or 112, the reasons therefor, and arguments in support of the patentability of the pending claim set are presented above. In light of these amendments and remarks, reconsideration and withdrawal of the outstanding rejections is respectfully requested.

Any claim amendments which are not specifically discussed in the above remarks are not made for patentability purposes, and it is believed that the claims would satisfy the statutory requirements for patentability without the entry of such amendments. Rather, these amendments have only been made to increase claim readability, to improve grammar, and to reduce the time and effort required of those in the art to clearly understand the scope of the claim language. Furthermore, any new claims presented above are of course intended to avoid the prior art, but are not intended as replacements or substitutes of any cancelled claims. They are simply

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additional specific statements of inventive concepts described in the application as originally filed.


If the Examiner has any questions which may be answered by telephone, he is invited to call the undersigned directly.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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